

**McELROY, DEUTSCH, MULVANEY & CARPENTER, LLP**

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U.S. DISTRICT COURT

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<p>BERGEN COUNTY RIBBON XCHANGE, LLC, d/b/a THE SUPPLIES GUYS,</p> <p>Plaintiff,</p> <p>v.</p> <p>SUPPLY GUYS, INC.,</p> <p>Defendant.</p>	<p>UNITED STATES DISTRICT COURT DISTRICT OF NEW JERSEY</p> <p>05-4870 (KSH) <u>Civil Action</u></p> <p><b>COMPLAINT AND DEMAND FOR TRIAL BY JURY</b></p>
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1. Plaintiff, BERGEN COUNTY RIBBON XCHANGE, LLC, d/b/a THE SUPPLIES GUYS, with its principal place of business at 555 Broad Street, Glen Rock, New Jersey, by way of Complaint against SUPPLY GUYS, INC., upon information and belief, a corporation organized pursuant to the laws of the State of Massachusetts, having a principal place of business at 226 Russell Street, Hadley, Massachusetts, alleges as follows:

**JURISDICTION AND VENUE**

2. This is an action for trademark infringement and cancellation pursuant to the Lanham Act and unfair competition pursuant to New Jersey law.

3. This court has subject matter jurisdiction over this proceeding by virtue of 28 U.S.C § 1331, 28 U.S.C. §1338, and with respect to certain claims, 28 U.S.C. § 1367.

4. Venue is proper in this district pursuant to 28 U.S.C. § 1391.

### **PARTIES**

5. Plaintiff Bergen County Ribbon Xchange, LLC d/b/a The Supplies Guys ("TSG"), is a limited liability company organized pursuant to the laws of the State of New Jersey, having a principal place of business at 555 Broad Street, Glen Rock, New Jersey.

6. Upon information and belief, Defendant Supply Guys, Inc. ("SG") is a corporation organized pursuant to the laws of the State of Massachusetts, having a principal place of business at 226 Russell Street, Hadley, Massachusetts.

### **FACTUAL BACKGROUND**

7. TSG is in the business of providing Internet-based retail sales of inks and toners for printers, copiers and fax machines, as well as similar consumable items.

8. Since as early as 1997, TSG and its predecessor-in-title have been trading under the name "The Supplies Guys." On information and belief, since as early as 1997, TSG and its predecessor-in-title have adopted and used the mark, "The Supplies Guys," and variations thereof, in connection with its services.

9. TSG provides an Internet website at [www.suppliesguys.com](http://www.suppliesguys.com), through which it provides on-line retail store services in the field of cartridges, inks, toners and similar consumable items for computer printers, copiers and fax machines using the service mark, "The Supplies Guys."

10. SG operates an Internet website at [www.supplyguys.com](http://www.supplyguys.com), through which it sells various computer-related goods and parts manufactured by others, including inks, printer and copier supplies and related consumable items, similar to those sold by TSG, under the name "Supply Guys."

11. On or about September 17, 1998, SG filed an application for registration ("Application for Registration") on the Principal Register with the United States Patent and Trademark Office for the trademark "SUPPLY GUYS" for "computers, computer accessories and supplies." Attached hereto as Exhibit A is a copy of SG's Application for Registration.

12. As part of SG's Application for Registration, Brian A. Zuckerman, President of SG, executed a Declaration, in which he attested that, "[t]o the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the above-identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, to cause confusion, or to cause mistake or to deceive...." See Application for Registration.

13. Subsequent to SG's filing of its Application for Registration, the examining attorney determined that SG's proposed identification was unacceptably indefinite and required that SG specify with greater particularity the goods to which the mark would apply.

14. On or about May 14, 1999, SG filed an Amendment to the Application providing a revised description of the categories of items for which the mark was sought, including specification of the goods on which the mark would be affixed and used.

15. SG obtained its registration of the "SUPPLY GUYS" trademark on November 9, 2004, for "Goods-Class 9," and now holds U.S. Trademark Reg. No. 2,900,959 for the word mark "SUPPLY GUYS" for goods listed as: "computers and notebook computers; computer accessories and peripherals, namely, blank computer

memory cards, blank discs, blank magnetic tapes, motherboards, computer interface boards, central processing units, disc drives, computer memory chips, modems, monitors, mice, mouse pads, power strips, speakers, keyboards, printers, scanners, power supplies, hard drive controllers, cameras, cables, computer terminals, surge protectors, computer network hubs, computer network cards, computer network servers, video tape recorders, video camcorders, compact disc players, computer furniture, sound cards, switches, buffers, routers and microprocessors" (the "Registration"). Attached hereto as Exhibit B is a copy of SG's Registration.

16. The Registration indicates that SG's first use of the "SUPPLY GUYS" trademark was July 29, 1998, and SG's first use in commerce of the "SUPPLY GUYS" trademark was August 24, 1998.

17. SG's first use and first use in commerce of the trademark "SUPPLY GUYS" for computer equipment and related items is subsequent to TSG and its predecessor-in-title's first use of its trade name and service mark, "The Supplies Guys."

### **COUNT I**

#### **(FEDERAL TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION)**

18. TSG repeats the allegations set forth in paragraphs 1 through 17 as if fully set forth herein.

19. TSG's prior use of "The Supplies Guys" trade name and service mark established priority rights over SG's use of any confusingly similar mark.

20. SG's use of its trademark and website with a confusingly similar name to TSG's service mark and trade name, "The Supplies Guys," constitutes infringement of

TSG's prior common law service mark and trade name and unfair competition in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125.

21. SG's use of its mark in connection with the goods identified in the Registration, and such goods and supplies that SG sells through its website, is likely to cause confusion, to cause mistake or to deceive, and based upon a recent admission by SG, has caused actual confusion.

22. SG has not responded to TSG's demand to cease and desist from this infringing use.

23. As a result of SG's actions and willful conduct, TSG has suffered, and continues to suffer, irreparable harm and damages.

WHEREFORE, Bergen County Ribbon XChange, LLC d/b/a The Supplies Guys demands judgment against Supply Guys, Inc. for:

- a. a preliminary and permanent injunction restraining Supply Guys, Inc., and its officers, agents and employees, and all persons acting in concert with any of them, from engaging in any further use of the name and trademark "SUPPLY GUYS" in connection with the sale of computers, computer accessories and parts, printer and copier inks, supplies and related consumables and as part of its website domain name.
- b. compensatory damages, exemplary damages, attorneys' fees, interest, costs of suit, and such other and further relief as this Court shall deem just and proper.

**COUNT II**

**(CANCELLATION OF REGISTRATION)**

24. TSG repeats the allegations set forth in paragraphs 1 through 23 as if fully set forth herein.

25. TSG has used the words "The Supplies Guys" as a trade name, and on information and belief, as a common law service mark, since 1997.

26. In 2004, SG obtained registration of the word mark "SUPPLY GUYS," for certain computer equipment, as Registered Mark No. 2,900,959, which is confusingly similar to TSG's common law service mark and trade name, "The Supplies Guys."

27. TSG's prior use of the "The Supplies Guys" trade name and service mark established priority rights over SG's use of any confusingly similar mark.

28. TSG is entitled to cancellation of SG's Registration pursuant to the Lanham Act, 15 U.S.C. § 1064(1), since the registered mark is confusingly similar to TSG's prior common law service mark and trade name and creates a likelihood of confusion with TSG's common law service mark and trade name.

WHEREFORE, Bergen County Ribbon Xchange, LLC d/b/a The Supplies Guys demands judgment against Supply Guys, Inc. for cancellation of Supply Guys, Inc.'s registered mark, "SUPPLY GUYS", Reg. No. 2,900,959, together with attorneys' fees, interest, costs of suit and such other and further relief as this Court shall deem just and proper.

**COUNT III**

**(CANCELLATION OF REGISTRATION)**

29. TSG repeats the allegations set forth in paragraphs 1 through 28 as if fully set forth herein.

30. TSG has used the words "The Supplies Guys" as a trade name and, on information and belief, a common law service mark, since 1997.

31. SG obtained registration of the word mark "SUPPLY GUYS," for certain computer equipment, as Registered Mark No. 2,900,959, which is confusingly similar to TSG's common law service mark and trade name, "The Supplies Guys."

32. As part of SG's Application for Registration, upon which SG obtained registration of the "SUPPLY GUYS" trademark, SG represented that, *inter alia*, no other individual or entity had priority rights in any confusingly similar mark.

33. On information and belief, SG's knew, or should have known about TSG's predecessor-in-title's business, trade name and service mark and that this representation was fraudulent when made.

34. TSG is entitled to cancellation of SG's Registration, pursuant to the Lanham Act, 15 U.S.C. § 1064(3) since the Registration was obtained fraudulently.

WHEREFORE, Bergen County Ribbon Xchange, LLC d/b/a The Supplies Guys, demands judgment against Supply Guys, Inc. for cancellation of Supply Guys, Inc.'s registered mark, "SUPPLY GUYS", Reg. No. 2,900,959, together with attorneys' fees, interest, costs of suit and such other and further relief as this Court shall deem just and proper.

**COUNT IV**  
**(UNFAIR COMPETITION)**

35. TSG repeats the allegations set forth in paragraphs 1 through 34 as if fully set forth herein.

36. The acts of SG complained of herein constitute unfair competition in violation of N.J.S.A. 56:4-1 and New Jersey common law.

37. As a result of SG's acts, TSG has suffered and continues to suffer, irreparable harm and damages.

WHEREFORE, Bergen County Ribbon Xchange, LLC d/b/a The Supplies Guys, demands judgment against Supply Guys, Inc. for:

- a. a preliminary and permanent injunction restraining Supply Guys, Inc., and its officers, agents and employees, and all persons acting in concert with any of them, from engaging in any further use of the name and trademark "SUPPLY GUYS" in connection with the sale of computers, computer accessories and parts, printer and copier inks, supplies and related consumables and as part of its website domain name.
- c. compensatory damages, attorneys' fees, interest, costs of suit, and for such other and further relief as this Court shall deem just and proper.

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Attorneys for Plaintiff

By: \_\_\_\_\_

John F. Whitcaker

October 6, 2005

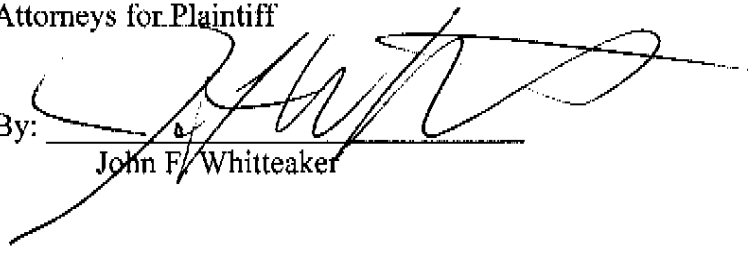


**DEMAND FOR JURY TRIAL**

TSG demands a trial by jury on all claims pursuant to Federal Rule of Civil

Procedure 38.

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